

REMARKS

The present application relates to hybrid maize plant and seed 38T27. Claims 1-32 are currently pending in the present application. Claims 11, 15, 19, 24, 28, and 32 have been amended. Applicant respectfully requests consideration in light of the following remarks.

REJECTIONS MAINTAINED UNDER 35 U.S.C. § 112, FIRST PARAGRAPH

Claims 1-9, 10(amended), 11-13, 14(amended), 15-17, 18(amended), 19-22, 23(amended), 24-26, 27(amended), 28-30, 31(amended), and 32 remain stand rejected under 35 U.S.C. § 112 first paragraph for the use of the hybrid designation 38T27 which the Examiner says must be made publicly available through deposit.

As applicant stated earlier, under 37 CFR 1.801-1.809, applicant wishes to refrain from deposit of hybrid 38T27 until allowable subject matter is indicated. The Examiner indicates that as no subject matter is as yet allowable the rejection stands. Upon indication of allowable subject matter claims will be amended as necessary to include the accession number as suggested by the Examiner.

REJECTIONS UNDER 35 U.S.C. § 112, SECOND PARAGRAPH

Claims 1-9, 10(amended), 11-13, 14(amended), 15-17, 18(amended), 19-22, 23(amended), 24-26, 27(amended), 28-30, 31(amended), and 32 remain rejected under 35 U.S.C. § 112 second paragraph for the recitation of "ATCC accession No. _____" in claims 1, 5, and 7. The Examiner notes that the recitation "Hybrid maize seed designated 38T27" in claims 1, 5, and 7, render the claims and those dependent thereon indefinite. The Examiner concludes that amending the claims to recite the ATCC deposit number would overcome the rejection. Applicants will refrain from amending the claim until the time of the actual deposit as set forth in 37 CFR 1.801-1.809.

Claims 11, 15, 19, 24, 28, and 32 remain rejected for reasons of record under item 4 of the previous office action. Applicant notes that this paragraph in the previous action related to claims 12-15 and claim 25-28 applicant assumes that it is paragraph 5 that the

Examiner wishes to indicate here. These claims stand rejected as being indefinite due to the phrases “wherein at least one ancestor” is the instant maize plant and “expressing a combination of at least two 38T27 traits” from a Markush group of traits such as “exceptional yield”, or “above average dry down” which the Examiner states are indefinite as there is no limitation on the degree of relatedness and as there is no standard for how to measure the traits listed in the Markush group.

Each of these claims have been amended to further define and describe Applicant’s invention. Each of these claims now defines the derived plant in terms of a reference plant (that of 38T27) and a statistical standard of measurement, stating that is trait is “not significantly different than” 38T27 at 5% significance when grown in the same environmental conditions. This provides a reference plant as well as a statistical measure by which the trait can be compared. It is submitted that this amendment should alleviate the Examiner’s concerns.

Issues Under 35 U.S.C. § 102/103

Claims 11, 15, 19, 24, 28, and 32, remain rejected under 35U.S.C. 102(b) as anticipated by or, in the alternative, as obvious under 35 U.S.C . 103(a) over Luedtke, Jr. for reasons of record. The Examiner notes that these claims are still taught by Luedtke, Jr. as cultivar 38T27 has at least two of the characteristics of the 38T27 plant listed in those claims.

The Examiner concludes that the process of making the claimed plants does not distinguish the plants themselves from those taught by the reference, concluding that the invention was clearly “prima facie” obvious as a whole to one of ordinary skill in the art, if not anticipated by Luedtke, Jr..

Applicant respectfully traverses and requests reconsideration of claims 11, 15, 19, 24, 28, and 32 as amended herein. When looking at maize plants it would be possible to find many traits that are similar between varieties such as the disease resistance or growth habit. However, to say that there are similarities in phenotype between two varieties is not the same as saying that the two varieties had the same morphological and physiological characteristics

as a whole, or that one is an obvious variant of the other. Further, similarity in phenotype does not mean that the two varieties will perform similarly, in identical environmental conditions or more particularly, in a breeding program. The claims as amended recite a specific reference variety and a specific statistical test which may be performed to determine whether in fact the traits observed are actually the “same”.

Any phenotypic trait that is expressed in the claimed plants is a result of a combination of all of the genetic material present in the 38T27 plant, and 38T27 will have its own unique genetic profile that it will contribute to a breeding program. This unique genetic background will result in the claimed plant and this profile and its combination with other plants will result in a unique combined genetic profile that is the product claimed.

A plant with the combination of two of these traits is also not rendered anticipated or obvious from Luedtke, Jr. It would require undue experimentation to begin with the hybrid of 38T27 which has its own unique combination of traits to breed with it to recover a hybrid with at least two of the traits enumerated in claims 11, 15, 19, 24, 28, and 32. Further, there is no expectation of success that the crossing of the hybrid 38T27 with some yet to be identified plant would yield a plant with two of the traits enumerated in the claim. Each generation would bring a random combination of traits and there is no expectation that the claimed combination could be achieved at all. Without any teaching about dominance, or heritability of such traits it cannot be said that there is an expectation of success that the combination of plants would achieve the combination enumerated in the claim, to say nothing of issues such as inbreeding depression etc. The laborious process of breeding to generate a hybrid is disclosed in the specification and to assume that another hybrid can be bred to generate the same grouping of traits when is speculation at best.

It is impermissible to use hindsight reconstruction and the benefit of applicants disclosure to cherry pick among pieces which are present in the art, there must be some suggestion to make the combination and an expectation of success. In re Vaeck 20 U.S.P.Q.2d 1434 (Fed. Cir. 1991). As discussed above, 38T27 is clearly differentiated from

38T27. Further, plants derived from 38T27 are also clearly differentiated. It must be recognized that the 38T27-derived plants are themselves unusual and a nonobvious result of a combination of previously unknown and nonobvious genetics. In addition to the phenotypic traits described herein, each 38T27-derived plant has an additional benefit unique to each specific cross using 38T27 as one of its ancestors. Thus, they deserve to be considered new and nonobvious compositions in their own right as products of crossing when 38T27 is used as a starting material.

CONCLUSION

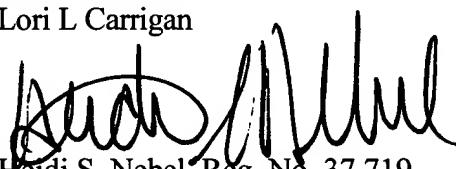
Applicant submits that, in light of the foregoing amendments and remarks, the claims, as amended, are in condition for allowance. The Examiner is invited to contact the undersigned at the number listed if this amendment does not result in allowable subject matter. Reconsideration and early notice of allowability are respectfully requested.

No fees or extensions of time are believed to be due in connection with this amendment; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account No. 26-0084.

Attached hereto is a marked-up version of the changes made to the specification and claims by the current amendment. The attached page is captioned "Version with markings to show changes made."

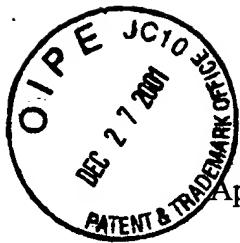
Reconsideration and allowance is respectfully requested.

Respectfully submitted,
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**AMENDMENT — VERSION WITH MARKINGS
TO SHOW CHANGES MADE**

In the Claims

Claims 11, 15, 19, 24, 28, and 32 have been amended as follows:

11. (Amended)

A maize plant, or its parts, wherein at least one ancestor of said maize plant is the maize plant, or its parts, of claim 2, said maize plant capable of expressing a combination of at least two [38T27] traits which are not significantly different from 38T27 when determined at a 5% significance level and when grown in the same environmental conditions, said traits selected from the group consisting of: a relative maturity [of approximately 96] based on the Comparative Relative Maturity Rating System for harvest moisture of grain, [excellent] yield potential, [above average] dry down, [above average] late season plant health, [consistent] yield performance under seasonal drought and high temperature stress, [above average] test weight, [above average] grain quality, [above average] resistance to Fusarium Ear Rot, [excellent] silage yield potential with readily available energy and whole plant digestibility, [excellent] resistance to head smut, [solid resistance to Northern Leaf Blight, solid resistance to Goss's Wilt, solid] resistance to Stewart's Wilt, and [well] suited to the Northwest, Northcentral, Northeast, Western and Drylands regions of the United States, to Canada, and to [Central and] Western Europe.

15. (Amended)

A maize plant, or its parts, wherein at least one ancestor of said maize plant is the maize plant, or its parts, of claim 12, said maize plant capable of expressing a combination of at least two [38T27] traits which are not significantly different from 38T27 when determined at a 5% significance level and when grown in the same environmental conditions, said traits

selected from the group consisting of: a relative maturity [of approximately 96] based on the Comparative Relative Maturity Rating System for harvest moisture of grain, [excellent] yield potential, [above average] dry down, [above average] late season plant health, [consistent] yield performance under seasonal drought and high temperature stress, [above average] test weight, [above average] grain quality, [above average] resistance to Fusarium Ear Rot, [excellent] silage yield potential with readily available energy and whole plant digestibility, [excellent] resistance to head smut, [solid resistance to Northern Leaf Blight, solid resistance to Goss's Wilt, solid resistant] resistance to Stewart's Wilt, and [well] suited to the Northwest, Northcentral, Northeast, Western and Drylands regions of the United States, to Canada, and to [central and] Western Europe.

19. (Amended)

A maize plant, or its parts, wherein at least one ancestor of said maize plant is the maize plant, or its parts, of claim 16, said maize plant capable of expressing a combination of at least two [38T27] traits which are not significantly different from 38T27 when determined at a 5% significance level and when grown in the same environmental conditions, said traits selected from the group consisting of: a relative maturity [of approximately 96] based on the Comparative Relative Maturity Rating System for harvest moisture of grain, [excellent] yield potential, [above average] dry down, [above average] late season plant health, [consistent] yield performance under seasonal drought and high temperature stress, [above average] test weight, [above average] grain quality, [above average] resistance to Fusarium Ear Rot, [excellent] silage yield potential with readily available energy and whole plant digestibility, [excellent] resistance to head smut, [solid resistance to Northern Leaf Blight, solid resistance to Goss's Wilt, solid resistant] resistance to Stewart's Wilt, and [well] suited to the Northwest, Northcentral, Northeast, Western and Drylands regions of the United States, to Canada, and to [Central and] Western Europe.

24. (Amended)

A maize plant, or its parts, wherein at least one ancestor of said maize plant is the maize plant, or its parts, of claim 20, said maize plant capable of expressing a combination of at least two [38T27] traits which are not significantly different from 38T27 when determined at a 5% significance level and when grown in the same environmental conditions, said traits selected from the group consisting of: a relative maturity [of approximately 96] based on the Comparative Relative Maturity Rating System for harvest moisture of grain, [excellent] yield potential, [above average] dry down, [above average] late season plant health, [consistent] yield performance under seasonal drought and high temperature stress, [above average] test weight, [above average] grain quality, [above average] resistance to Fusarium Ear Rot, [excellent] silage yield potential with readily available energy and whole plant digestibility, [excellent] resistance to head smut, [solid resistance to Northern Leaf Blight, solid resistance to Goss's Wilt, solid resistant] resistance to Stewart's Wilt, and [well] suited to the Northwest, Northcentral, Northeast, Western and Drylands regions of the United States, to Canada, and to [Central and] Western Europe.

28. (Amended)

A maize plant, or its parts, wherein at least one ancestor of said maize plant is the maize plant, or its parts, of claim 25, said maize plant capable of expressing a combination of at least two [38T27] traits which are not significantly different from 38T27 when determined at a 5% significance level and when grown in the same environmental conditions, said traits selected from the group consisting of: a relative maturity [of approximately 96] based on the Comparative Relative Maturity Rating System for harvest moisture of grain, [excellent] yield potential, [above average] dry down, [above average] late season plant health, [consistent] yield performance under seasonal drought and high temperature stress, [above average] test weight, [above average] grain quality, [above average] resistance to Fusarium Ear Rot, [excellent] silage yield potential with readily available energy and whole plant digestibility, [excellent] resistance to head smut, [solid resistance to Northern Leaf Blight, solid resistance to Goss's Wilt, solid resistant] resistance to Stewart's Wilt, and [well] suited to the

Northwest, Northcentral, Northeast, Western and Drylands regions of the United States, to Canada, and to [Central and] Western Europe.

32. (Amended)

A maize plant, or its parts, wherein at least one ancestor of said maize plant is the maize plant, or its parts, of claim 29, said maize plant capable of expressing a combination of at least two [38T27] traits which are not significantly different from 38T27 when determined at a 5% significance level and when grown in the same environmental conditions, said traits selected from the group consisting of: a relative maturity [of approximately 96] based on the Comparative Relative Maturity Rating System for harvest moisture of grain, [excellent] yield potential, [above average] dry down, [above average] late season plant health, [consistent] yield performance under seasonal drought and high temperature stress, [above average] test weight, [above average] grain quality, [above average] resistance to Fusarium Ear Rot, [excellent] silage yield potential with readily available energy and whole plant digestibility, [excellent] resistance to head smut, [solid resistance to Northern Leaf Blight, solid resistance to Goss's Wilt, solid resistant] resistance to Stewart's Wilt, and [well] suited to the Northwest, Northcentral, Northeast, Western and Drylands regions of the United States, to Canada, and to [Central and] Western Europe.